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09/889,826	07/23/2001	Katsuki Ogawa	IWA-173-PCT	1426

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EXAMINER

OSTRUP, CLINTON T

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 03/04/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/889,826

Applicant(s)

OGAWA ET AL.

Examiner

Clinton Ostrup

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-- Th MAILING DATE of this communication appears on th cover sheet with the correspond nce address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-8 and 12-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-8 and 12-31 is/are rejected.
- 7) ☒ Claim(s) 12-14, 16, 18-24 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>9</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other:   |

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## **DETAILED ACTION**

Claims 2-8 and 12-31 are pending in this application.

### **Response to Applicant's Amendment**

#### *Priority*

The amendment to the specification filed November 6, 2002, Paper No. 7, and has made the examiner's objection to the priority request moot. Therefore, said objection has been withdrawn and priority to Japanese Application No. 11-334101, filed November 25, 1999, Japanese Application No. 2000-890, filed January 6, 2000, and PCT/JP00.08328, filed November 27, 2000 has been acknowledged is acknowledged.

#### *Oath/Declaration*

The declaration filed November 6, 2002, Paper No. 6 has made the examiner's objection to the previous declaration moot. Therefore, the said objection has been withdrawn.

#### *Specification*

The amended substitute specification filed November 6, 2002, Paper No. 7, has made the examiner's objection moot. Therefore, said objection has been withdrawn.

#### *Withdrawn Claim Rejections - 35 USC § 102*

Applicant's amendment and cancellation of claims 1 and 9-11 in Paper No. 7, has made the rejection of said claims under 35 U.S.C. 102(b) moot. Therefore, the said rejection has been withdrawn.

#### *Maintained Claim Rejections - 35 USC § 103*

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Applicant's amendment and arguments filed November 6, 2002, Paper No. 7, to the rejection of claims 1-8, 15, 17, and 25-30 under 35 U.S.C. 103(a) as being unpatentable over Hockmeyer et al., EP 0,546,715 A1 and further in view of SUNSTAR INC, JP 09286713 A and ISHIHARA SANGYO KAISHA, LTD., WO98/16193 have been fully considered, however, the arguments are not deemed persuasive. Therefore, the said rejection has been MAINTAINED.

However, applicant's amendment and arguments in regard to claims 12-14, 16 and 31 have been found convincing and the rejection has been WITHDRAWN from these claims.

Applicants argue that the media mill of Hockmeyer is an apparatus that disperses a powder to a solvent and the emulsification or the hydrophobicity process of the powder is not described. However, reading each of the independent claims 2, 7, 12, 15, 17, 25, and 30 as broadly as possible, the emulsification or hydrophobicity process is not required. This is evident by the fact that the powder components are dispersed with oil components **OR** aqueous components. Thus, if the powder components are dispersed with aqueous components, the emulsification or hydrophobicity processes are not required, as claimed instantly. Therefore, the process of Hockmeyer, wherein an apparatus is disclosed that is capable of dispersing a powder to a solvent makes the instantly rejected claims obvious over the combination of references as described in the Office Action mailed May 9, 2002, Paper No. 4.

Applicant argues that none of the references mention oil and the instant claims are drawn to mixing powdered components and an oil phase component. First, as

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discussed directly above, applicant's arguments are not commensurate with what is being claimed, as the powder components may be dispersed using aqueous components. Secondly, SUNSTAR INC. teaches silicone oils for the surface treatment of fine cosmetic particles and combining 1-40% of the composite powder can be used to make emulsified cosmetics. See: Page 9 [0012], page 10, [0015]. ISHIHARA SANGYO KAISHA, LTD discloses silicone oils as dispersion oils which are pulverized together with titanium dioxide. See: page 4, paragraph 4 – page 6, paragraph 1.

Applicant then argues that the SUNSTAR INC. reference does not suggest the use of a basket-type stirring mill, however, this is an obviousness-type rejection and the basket-type mill is clearly taught by the primary reference. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that the percentages set forth in claim 8 are not found in any of the references, however, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Moreover, as discussed above, SUNSTAR INC. teaches combining 1-40% of the composite powder to make emulsified cosmetics, thus teaching the general conditions of the claim.

Applicant argues that none of the three references suggest an oil component. The examiner respectfully disagrees for the reasons set forth above. Applicant argues

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that there is no suggestion that cosmetics may be made with the media agitating mill as taught by Hockmeyer, however the examiner respectfully disagrees. ISHIHARA SANGYO KAISHA, LTD teaches a method of dispersing the particulate titanium dioxide in silicone can be done by a vane-type agitator, dispenser, and a homogenizer and Hockmeyer teaches that his invention is related to dispersing powdered solids into liquids. Thus one skilled in the art would readily see the obviousness of using the basket-type mill of Hockmeyer because of the expectation that the methods of dispersing a powder into a liquid vehicle would easily be applied to a fine particulate titanium dioxide powder in a silicone-base cosmetic material. Moreover, applicant's argument regarding the aggregated particle of the powder, which is ground to form a slurry, is not convincing because SUNSTAR INC. teaches the formation of a slurry by combining the powder compounds, a solvent, and a surface-treating agent. See: page 11-12 [0018].

Applicant argues that the removal of solvent from the slurry as claimed in claim 3 and the suction press molding are not discussed in the references, however, SUNSTAR INC. teaches vacuum distillation. See: page 12, line 11-14.

In regard to applicant's argument that none of the references teach the removal of the solvent by dry press molding, the examiner respectfully agrees. However, the examiner disagrees that this limitation would not be obvious to the skilled artisan. Dry press molding is a common technique and a skilled artisan would readily recognize dry press molding as an obvious method step that could be used for making cosmetic products.

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Applicant argues that the percentages set forth in claim 6 are not found in any of the references, however, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical, as discussed above.

Applicant's argument that the in-tank stirring device is a turbinal blade and does not interfere with the route of fluid coming into or out of the basket has been found convincing and the rejection of claims 12-14 has been withdrawn.

Applicant's argument that the oil component of claim 15 is not disclosed by the references is not convincing for the reasons set forth above, as the references teach oil components and the instant claims may be drawn to a dispersion of powder components and aqueous components.

Applicants argument that the references do not teach the addition of a solidifying aid followed by stirring and heating has been found convincing. Thus, the rejection of claim 16 has been withdrawn.

Applicants argue that the emulsification of cosmetic products through the use of a media-agitating mill has not been suggested by the references and that the word "emulsification" simply does not appear in the secondary and tertiary references. The examiner respectfully disagrees. As discussed above, SUNSTAR INC teaches the formation of emulsions and even describes the amount of powder to be used in said emulsions and the Hockmeyer et al. reference is not limited to non-emulsified compositions.

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Applicant has argued the rejection of claims 18-24 over the combination of Hockmeyer et al., EP 0,546,715 A1 and further in view of SUNSTAR INC, JP 09286713 A and ISHIHARA SANGYO KAISHA, LTD., WO98/16193. However, these claims were not rejected over the said combination, these claims were rejected over the combination of these references and further in view of KOSE CORP, JP 09-002816. For clarification purposes, these claims and applicant's arguments will be discussed after the instant rejection.

Applicant again argues that none of the cited references teach an oil phase, however, the examiner respectfully disagrees for the reasons set forth above. Applicant further argues that the references do not suggest a media-agitating mill to impart hydrophobicity followed by a step for adding an emulsifier and a water phase. However, the examiner respectfully disagrees. The primary reference teaches a basket media-mill and both the secondary and tertiary references teach surface treatment of powders with silicone oils. Furthermore, the secondary reference teaches that the compositions may be in the form of emulsions and teaches that surfactants may be added to the cosmetics, in a range that does not impair the effect of the invention.

The applicant's arguments with regards to the media-agitating tank and stirring device is not convincing because Hockmeyer et al., teach a basket media mill with stirring capabilities and the tank disclosed in Hockmeyer meets the specific limitations stirring tank as claimed instantly.

Applicant's argument that the references do not teach oil as claimed in claim 30 is not convincing for the reasons set forth above.



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Applicant's amendment and arguments to the rejection of claims 11 and 18-24 under 35 U.S.C. 103(a) as being unpatentable over Hockmeyer et al., EP 0,546,715 A1, SUNSTAR INC, JP 09286713 A, ISHIHARA SANGYO KAISHA, LTD., WO98/16193 and further in view of KOSE CORP, JP 09-002816 have been fully considered and deemed persuasive. Therefore, the said rejection has been withdrawn.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-10, 12-17, 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hockmeyer et al., EP 0,546,715 A1 and further in view of SUNSTAR INC, JP 09286713 A and ISHIHARA SANGYO KAISHA, LTD., WO98/16193.

Hockmeyer et al., provides a basket media mill and a method for dispersing powdered solids into liquid vehicles for the manufacture of paints, coatings, and inks. The reference teaches that their invention is effective in accepting unmixed pigment and liquid vehicle directly into the mixing vessel and then effectively grinds and disperses the pigment in the vehicle in a short amount of time. See: col. 1, line 1 – col. 2, line 15; col. 8, line 45 – col. 11, line 46; and abstract.

Although the primary reference provides an apparatus and a general concept of the types of powders and vehicles which may be used, the primary reference lacks the specific powders, oils, and cosmetic products as claimed instantly in claims 1-31.

SUNSTAR INC teaches cosmetic compositions with improved dispensability by blending two powders and a solvent together via a wet grinding treatment in a medium

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stirring mill. The reference describes how the cosmetic cream exhibits an excellent ultraviolet rays blocking ability and an excellent dispersibility. See: abstract.

ISHIHARA SANGYO KAISHA, LTD., discloses ultraviolet-screening dispersions of particulate titanium dioxide in a stable silicone-base cosmetic material, said dispersion is prepared by dispersing particulate titanium dioxide in a silicone medium using a dispersant. See: abstract.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the general methods of dispersing powdered solids into liquid vehicles as taught by Hockmeyer et al., to formulate cosmetic compositions with ultraviolet blocking, skin protecting properties as taught by SUNSTAR INC and ISHIHARA SANGYO KAISHA, LTD because of the expectation that the methods of dispersing a powder into a liquid vehicle would easily be applied to a fine particulate titanium dioxide powder in a silicone-base cosmetic material. Furthermore, the method of filling and molding cosmetic products into containers using known methods would have been obvious to the skilled artisan, as the formulation must be processed into a usable form.

### ***New Claim Rejections***

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 2-8 and 12-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of the independent claims 2, 7, 12, 15, 17, 18, 25, and 30 claim that the powder components are dispersed with oil components **OR** aqueous components. Thus, if the powder components are dispersed with aqueous components, then the emulsification or hydrophobicity processes are not required. It is unclear from the claimed subject matter how the powder components dispersed in the aqueous components would require emulsification or hydrophobicity as claimed and therefore, the instant claims are vague and confusing.

Any remaining claims are rejected as depending on indefinite base claims.

### ***Claim Objections***

Claims 12-14 and 18-24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 16 and 31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clinton Ostrup whose telephone number is (703) 308-3627. The examiner can normally be reached on M-F (8:30am-5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Clinton Ostrup  
Examiner  
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A handwritten signature in black ink, appearing to read 'Clinton Ostrup', with a stylized flourish at the end.

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March 3, 2003